



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,173	03/09/2001	Chong Seng Cheng	1601457-0004	9334

7590 02/03/2006

White & Case LLP  
Attn: Patent Department  
1155 Avenue of the Americas  
New York, NY 10036

EXAMINER

CHOI, WOO H

ART UNIT PAPER NUMBER

2189

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,173

Applicant(s)

CHENG, CHONG SENG

Examiner

Woo H. Choi

Art Unit

2189

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/28/05, 12/27/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

2. Claim 22 is objected to because of the following informalities:

The acronym CD should be spelled out prior to its first appearance. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22 – 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. With respect to claim 22, the specification as originally filed does not support the limitation “a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling portable data storage device directly to a USB socket on a computer”. Closest support for the limitation can be found in figure 1, element 1, and figure 2, step 20 and their corresponding descriptions in the specifications. However, while the specification discloses a USB plug and that “the plug 1 of the device 10 is plugged into 20 to a USB socket on the computer” (specification page 5, lines 18 – 19), it does not disclose that the USB plug 1 of the device is capable of coupling **directly** to a USB socket on a computer. Nor does the specification support the limitation “**without an intervening cable**” limitation.

The specification as originally filed does not support the limitation “a USB plug **integrated into the unitary** portable data storage device”. This limitation has been introduced specifically to avoid a prior art reference applied in one of the previous rejections that discloses a two-piece construction of applicant’s claimed device. The specification is silent as to whether the plug is integrated and the portable device is of unitary construction.

The specification as originally filed does not support the limitation “said memory being **non-removable** from the unitary portable data storage device”. Again, this limitation has been added specifically to avoid a prior art reference applied in one of the previous rejections that discloses applicant’s claimed device with removable memory. Whether the memory is non-removable or not is not disclosed in the specification as originally filed.

The specification as originally filed does not support the limitation “and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” While the specification discloses that magnetic disks and CD ROMs are examples of conventional devices, it does not disclose that the claimed non-volatile memory has sufficient capacity to serve as an alternate to a magnetic disk or CD. Capacity of the claimed non-volatile memory is not discussed anywhere in the specification. The specification as originally filed does not support the limitation “in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” Applicants are asked to specifically point out where in the specification these limitations are supported.

6. Claims 23 – 29 contain the deficiencies of their parent claim as discussed above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 22 – 24, and 26 – 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller (US Patent No. 6,038,320).

9. With respect to claims 22 – 24, and 28, Miller discloses a unitary portable data storage device (figure 3) comprising:

a USB plug (figure 3, 48) integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer;

a single interface (figure 3, interface between the plug 48 and the controller 42), said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

Art Unit: 2189

a memory controller (42); and

a non-volatile solid-state memory (46), said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (Miller's device has sufficient capacity to serve as an alternative to other alternative memories, such as a magnetic disk or CD, that can be used to store encrypted passwords); and

the memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug (figure 3, col. 2 line 59 – col. 4, line 7) in a manner to enable the unitary data storage device to serve as an alternative to a magnetic disk or CD.

10. With respect to claim 26, the memory controller comprises a micro-controller (col. 2, line 65).

11. With respect to claim 27, the micro-controller includes a read-only memory which stores a program to control the operation of the micro-controller (col. 3, lines 13 – 15).

12. Claims 22 – 24, and 26 – 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (US Patent No. 6,457,099).

Gilbert discloses a unitary portable data storage device (figure 2, 100) comprising:

Art Unit: 2189

a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (col. 7, lines 11 – 30, just like applicant's device, Gilbert's device plugs into a computer, see lines 23 – 24);

a single interface, said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug (a USB interface is required for the USB embodiment of Gilbert's device) ;

a memory controller (figure 1, 102, 104);

and a non-volatile solid-state memory (figure 1, 106, 108, 110, 112, see also col. 3, lines 42 – 47 and col. 4, lines 16 – 22), said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (Gilbert's device has sufficient capacity to store applications);

the memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Kondo *et al.* (US Patent No. 6,786,417, hereinafter "Kondo").

Miller discloses all of the limitations of the parent claim as discussed above. However, Miller does not specifically disclose a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented. On the other hand, Kondo discloses a flash memory device with a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented (figures 3 and 4, element 6 activates the switch, col. 4, line 65 – line 3).

It would have been obvious to one of ordinary skill in the art, having the teachings of Miller and Kondo before him at the time the invention was made, to use the accidental erasure prevention teachings of the compact portable flash memory card of Kondo in the compact portable flash memory card of Miller, in order to prevent accidental erasures of flash memory content (Kondo, col. 1, line 66 – col. 2, line 1).

15. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Kondo.

Gilbert discloses all of the limitations of the parent claim as discussed above. However, Gilbert does not specifically disclose a manually operated switch movable between a first

Art Unit: 2189

position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented. On the other hand, Kondo discloses a flash memory device with a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented (figures 3 and 4, element 6 activates the switch, col. 4, line 65 – line 3).

It would have been obvious to one of ordinary skill in the art, having the teachings of Gilbert and Kondo before him at the time the invention was made, to use the accidental erasure prevention teachings of the compact portable non-volatile memory card of Kondo in the compact portable non-volatile memory card of Miller, in order to prevent accidental erasures of memory content (Kondo, col. 1, line 66 – col. 2, line 1).

16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit *et al.* (US Patent No. 6,748,541, hereinafter “Margalit”) in view of Jha *et al.* (US Patent No. 6,407,949, hereinafter “Jha”).

Margalit discloses all of the limitations of the parent claim 22 as follows:

a unitary portable data storage device (figure 1, 10) comprising:

a USB plug (col. 4, line 23) integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (figure 5B);

Art Unit: 2189

a single interface (figure 1, 40), said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

a memory controller (30); and

a non-volatile solid-state memory (50 and 70, col. 4, lines 35 – 41), said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (Margalit's device has sufficient capacity to serve as an alternative to other alternative memories, such as a magnetic disk or CD, that can be used to store user data); and

the memory controller being coupled between the interface and the memory (see figure 1) to control the flow of data between the memory and the USB plug in a manner to enable the unitary data storage device to serve as an alternative to a magnetic disk or CD.

However, Margalit does not specifically disclose that the non-volatile solid-state memory is divided into a plurality of zones, each of said plurality of zones requiring a unique password for access. On the other hand, Jha discloses these limitations (figure 4).

It would have been obvious to one of ordinary skill in the art, having the teachings of Margalit and Jha before him at the time the invention was made, to use the zoned password protection teachings of the flash memory Jha in the flash memory device of Margalit, in order to prevent inadvertent erasures or reprogramming of portions of the flash memory (Jha, col. 11, lines 17 – 19).

*Response to Arguments*

17. Applicant's arguments filed March 21, 2005, have been fully considered but they are not persuasive.

Rejections under 35 U.S.C. 112, first paragraph

18. The Examiner does not agree with Applicant that the specification explicitly, implicitly or inherently discloses “a USB plug **integrated** into the unitary portable USB device **without an intervening cable** capable of coupling the unitary portable storage device **directly** to a USB socket of a computer” as Applicant alleges. The Examiner agrees that the specification discloses that a USB plug of the disclosed device 10 is plugged into a USB socket on a computer.

However, whether this connection is **direct** and **without a cable** is not disclosed at all. As mentioned in one of the earlier actions, the physical characteristics of the claimed device have not been disclosed at all in the specification as originally filed. Mere absence of a positive recitation is not basis for an exclusion. Any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP 2173.05(i).

19. Regarding the Kim and Hyde affidavits, they express personal opinions. As mentioned in the last action, personal opinions are of little probative value. Their opinions do not establish any factual basis to conclude that one of ordinary skill in the art at the time of invention would have immediately understood that a disclosure of an unspecified type of USB plug plugging into an unspecified type of a USB socket in an unspecified computer implicitly means a direct connection without a cable. In fact, at page 5, paragraph 19, of affidavit of Youngmin Kim

Art Unit: 2189

submitted March 21, 2005, professor Kim states “at the time of invention, D12 would typically be proximately connected to a USB “B”-type socket rather than a USB “A”-type plug.” This is strong evidence that one skilled in the art would have associated Applicant’s claimed device that uses D12 with a USB “B”-type plug and socket which cannot be used to plug directly into a type-A socket of a computer without an intervening cable. If eliminating the need for USB “B”-type socket and intervening cable is indeed Applicant’s innovation as professor Kim suggests, this innovation should have been specifically disclosed and claimed when the application was originally filed. Essential matter and innovative features cannot be added after the fact merely to overcome prior art rejections.

20. Regarding the “a USP plug **integrated** into the **unitary** portable data storage device” and “non-removable” limitations, again the specification is silent as to whether the plug is integrated and the construction of the device is unitary. Mere fact that the device is referred to in the specification in a singular form does not mean that this device is of unitary construction. Again, as mentioned in the earlier action, Yao reference (US Patent No. 6,385,677), which seems to have caused the new limitations to be added, shows a single device (figure 5) of two-piece construction. Applicant has not shown that Yao’s device is not a single device. Applicant further argues “a device designed to include multiple user-removable components during the normal course of usage will not be understood by a skilled artisan as a single or singular device.” Mere arguments are not sufficient to overcome the rejections. Applicant offers not factual basis to make such a conclusion. In fact, an entire personal computer can be understood to be a single

Art Unit: 2189

device. A mother board for a personal computer can be considered a single device even though CPUs and memory modules are removable.

Likewise, Applicant's argument regarding non-removable memory is not persuasive. Personal opinions and arguments are not sufficient to overcome the fact the disclosure remains silent as to whether the memory is non-removable. The Examiner finds Applicant's contention that lines 8 – 10 on page 2 supports the claimed integrated device with non-removable part goes well beyond the bounds of what is reasonable to the point of being absurd. Clearly, the reference to the absence of moving parts refers to the absence of drive mechanisms or any mechanical moving parts associated certain rotating prior art devices. Moreover, even memory devices with moving parts, such as a portable hard drive, can be of unitary portable construction with non-removable media, i.e., non-removable memory.

21. As to Applicant's argument regarding written description support for "sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD" limitation, again, Applicant's arguments are not persuasive. It is true that magnetic disks and CD ROMs are mentioned along with RAMs and ROMs in the background section of the application discussing different types of prior art devices and shortcomings of these devices. However, there not even a single phrase that suggests that the claimed device was meant to have enough capacity to serve as an alternative to a magnetic disk or CD. The only thing that can be inferred from the background section of the specification is that Applicant's invention is directed to a new type of device without the listed shortcomings of the prior art devices discussed, such as non-portability and moving parts. The disclosure is silent as to whether Applicant's device was

Art Unit: 2189

meant to have enough capacity to serve as an alternative to magnetic disks and CDs. Capacity requirements of Applicant's invention are not discussed at all in the specification or anywhere else.

22. In order to satisfy the written description requirement, the disclosure as originally filed "must ... convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention." Vas-Cath Inc. v. Mahurkar, 935, F.2d 1555, 1563-64, 19 UPSQ2d 1111, 1117 (Fed. Cir. 1991). Put another way, one skilled in the art, reading the original disclosure, must "immediately discern the limitation at issue" in the claims. Waldermar Link GmbH & Co. v. Osteonics Corp., 32 F.3d at 558, 31 UPSQ2d at 1857.

In this case, the specification fails to convey with reasonable clarity to those skilled in the art that the inventor was in possession of the claimed invention that includes new matter added via amendments. One skilled in the art cannot immediately discern the limitations at issue by reading the original disclosure.

#### Rejections based on Miller reference

23. Applicant's argument that Miller's device does not have sufficient capacity to enable the device to serve as an alternate to a magnetic disk or CD is not persuasive. First of all, the capacity of the device is not discussed at all in the specification. Nor does the specification disclose what capacity is sufficient for the device to serve as an alternate to a magnetic disk or a CD. Secondly, Miller's device has enough capacity to serve as an alternate to a magnetic disk or

Art Unit: 2189

CD that stores an encrypted password. As to Applicant's argument regarding "sending back the original user's data", this limitation is nowhere to be found in the claim.

Rejections based on Gilbert reference

24. Applicant's argument that Gilbert does not teach or disclose a USB plug integrated into unitary device or a storage device as claimed is an implicit admission that the claimed limitations are not supported by the specification, since the level of Gilbert's disclosure in this regard is comparable to that of Applicant's. Gilbert discloses that an external PDAC is connected to a host computer via a USB (col. 7, lines 12 – 16) and that the external PDAC can simply be plugged into any host computers (col. 7, lines 24 – 25). Gilbert discloses the limitations in question as much as Applicant does. Applicant's discussion of Gilbert's preferred embodiment and whether the PDAC is internal or external is irrelevant as to whether Gilbert discloses a USB plug. Gilbert clearly suggests a USB interface. Gilbert also unambiguously states that a user can simply **plug** the external PDAC into any host computer. Gilbert implicitly, if not inherently, discloses a plug with this statement. Applicant has conveniently ignored this point and has not rebutted this disclosure. Thus, Applicant has not overcome the prima facie evidence of a USB plug.

25. Applicant also argues that Gilbert does not teach "a portable storage device capable of serving as an alternative to a magnetic disc or CD" line the present invention, because a PDAC executes dedicated software applications pre-stored before shipping. As Applicant argued, PDAC is its own stand-alone computer system. However, this does not preclude the PDAC from



Art Unit: 2189

having enough capacity to serve as an alternative to a magnetic disk or CD. In fact, Gilbert specifically discloses and Applicant admits that PDAC has enough capacity to stores application software.

Obviousness rejections and secondary considerations

26. Applicant's arguments regarding Miller and Gilbert references have been addressed above. Applicant presents no new argument regarding the specific combinations used in the rejections under obviousness.

27. Applicant's argument with respect to the Margalit reference regarding the storage capacity is even less persuasive than the one offered against the Miller reference. The device disclosed by Margalit is clearly a user data storage device. As mentioned above, Applicant's disclosure is silent as to the capacity of the claimed storage device. If Applicant's argument that the capacity of Margalit's is too small to meet the claimed limitation is to be accepted as urged, Applicant would in effect be arguing to find the claim indefinite, as Applicant disclosed no standard to determined what is and what is not sufficient capacity to serve as an alternative to a magnetic disk or CD. As mentioned before, the specification is silent as to the storage capacity of the claimed device.

28. Paragraphs 20 – 22 of Hyde affidavit that Applicant points to support non-obviousness of Margalit and Jha combination mainly discusses speed of a smart card interface. Speed of an

Art Unit: 2189

interface of a smart card is not an issue in the rejection. The claims do not require that the device operate at speeds similar to a disk or CD.

29. As to the secondary considerations such as unsolved needs and commercial success, again, the Hyde affidavit fails to address the issues. The main issue of obviousness in the Miller-Kondo and Gilbert-Condo combinations is the manual switch. Hyde affidavit does not address an unsolved long felt need for a manual switch at all. Likewise, Mr. Hyde specifically states at paragraph 12, the commercial success of the device, alleged to be the commercial embodiment of the claimed device, is because of all of its features and not specifically because of its manual switch. Moreover, Mr. Hyde's statement regarding the number of units sold is hearsay. He seems to be relaying what someone else advised him.

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Casey (US Patent No. 6,011,486) discloses a device with flash memory having a USB plug that directly plugs into a host anticipating the claimed invention.

**31. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

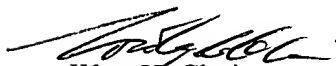
Art Unit: 2189

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Woo H. Choi whose telephone number is (571) 272-4179. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Woo H. Choi  
January 26, 2006